REMARKS/ARGUMENTS

Claims 1-3 and 10-12 were pending in this application before the present response.

In the Office Action dated February 7, 2008, claims 11 and 12 are objected to. Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph. Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese et al. (US 2002/0141732, hereinafter "Reese") in view of Barton et al. (US 2003/0095791, hereinafter "Barton"). Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese in view of Barton and further in view of Asano et al. (US 2003/0051151, hereinafter "Asano").

Claims 11-12 have been amended in this response. No new matter is added by the amendments. No amendment made is related to the statutory requirements of patentability unless expressly stated herein. No amendment is made for the purpose of narrowing the scope of any claim. Any remarks made herein with respect to a given claim or amendment is intended only in the context of that specific claim or amendment, and should not be applied to other claims, amendments, or aspects of Applicant's invention.

Claims 1-3 and 10-12 are now pending in this application. Applicant respectfully requests reconsideration and allowance of all pending claims, in view of the amendments and following remarks.

Claim Objections

Claims 11 and 12 were objected to because the limitation "the content" is allegedly not definitive, with respect to its antecedent basis. Applicant thanks the Examiner for the suggested correction. In the present amendment, Applicant has addressed the objection as required by the Examiner. Accordingly, Applicant requests that the objection be withdrawn.

Claim Rejections – 35 U.S.C. § 112, ¶ 1

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph. The Office Action requires "support from the specification for the amendment to claim 1 that includes the method step of 'determining whether the requested content resides in an encrypted form on the first hard disk recorder' and 'determining whether the requested content resides in the encrypted form on a second hard disk' (claim 1)." Applicant respectfully traverses the rejection.

The method step of "determining whether the requested content resides . . . on the first hard disk recorder" is supported at least by FIG. 4, ref. 406, and by page 8, lines 7-8 of the specification as filed.

The method step of "determining whether the requested content resides . . . on a second hard disk" is supported at least by FIG. 4, ref. 408, and by page 8, lines 11-14 of the specification as filed. The specification recites, "**Once the content is located** on the second hard disk recorder 104, method 400 proceeds to step 410" (emphasis added), thus supporting the method step of claim 1 by indicating that a determination takes place as to whether the content resides on the second hard disk. Such a determination is clearly supported, because if the content could not be located on the second hard disk, the method 400 could not proceed to display the content at step 410.

In each of these steps, the additional limitation of "in an encrypted form" is supported at least by page 7, lines 17-21, which describes the encryption of content that is stored on the first hard disk recorder. This is to be read together with page 8, lines 1-2, which continue the same discussion of **encrypted** content, by adding that "beside storing the [encrypted] content on the first hard disk recorder, the [encrypted] content can also be stored on any of the other hard disk recorders," such as the second hard disk recorder.

The limitations are further supported by Page 3, lines 14-15, which point out that "content may be shared between two or more hard disk recorders, while preserving the integrity and **security** of the content" (emphasis added), where "security" refers at least to the fact that content is stored in the encrypted form, rather than in the clear (see page 3, lines 1-10).

For at least the foregoing reasons, the foregoing limitations are supported by the specification, and do not constitute new matter. Accordingly, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Claim Rejections – 35 U.S.C. § 103

Claims 1-3 were rejected as allegedly unpatentable over Reese in view of Barton. Claims 10-12 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese in view of Barton and further in view of Asano. Applicant respectfully submits that the rejection of claims 1-3 and 10-12 under 35 U.S.C. § 103(a) should be withdrawn.

Independent claim 1, as amended, requires, *inter alia*, "determining whether the requested content resides in an encrypted form on the first hard disk recorder, wherein the encrypted form comprises encryption via a local encryption scheme" and "if the requested content does not reside on the first hard disk recorder, determining whether the requested content resides in the encrypted form on a second hard disk recorder".

Applicant submits that neither Reese nor Barton discloses at least the aforementioned features of independent claim 1. In particular, it is submitted that secondary citation to Barton does not remedy deficiencies in the primary citation to Reese. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of Reese and Barton is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The Examiner states that "Reese decodes video content . . . , but does not expressly mention the encryption schemes." (Office Action, p. 6.) Applicant agrees with the Examiner that the claimed limitations are missing from Reese. To the extent that the Examiner contends that the missing limitations can be found in Barton, this contention is respectfully traversed.

Reese is directed to "adapting each DVR to control, via an Ethernet network, all the other video recording devices (DVRs) on the network" (Reese, para. 0011), where each digital video recorder-controller (DVRC) receives video signals from video cameras (FIGs. 1 and 2, para. 0015). The Office Action, at page 7, contends that Reese teaches "determining whether the requested content resides . . . on a second hard disk recorder,"

citing paragraphs 0020 and 0023 for this feature. Applicant respectfully traverses the Office Action's strained characterization of Reese, which contends that Reese discloses that a master DVRC "can issue a control signal to itself . . . and display the selected video image whether it resides on the master DVRC or from other DVRs or DVRCs in the network." (Office Action, p. 7.) No discussion of such features appears in paragraphs 0020 and 0023 of Reese, or elsewhere in Reese. Reese fails to teach "determining whether the requested content resides . . . on a second hard disk recorder," as recited in claim 1.

The Examiner notes, and the Applicant concedes, that paragraph 0085 of Barton "teaches storing encrypted content on a hard disk" (Office Action, p. 3). Applicant acknowledges that Barton states that "the media content is decrypted only if it is viewed, thus protecting the content from theft. It is possible for the DVR to save these encrypted media streams to disk, and initiate decryption upon playback" (para. 0085).

However, Applicant respectfully submits that Reese and Barton, including the cited passage from Barton, fail to teach the presently claimed features of "determining whether the requested content resides in an encrypted form on the first hard disk recorder, wherein the encrypted form comprises encryption via a local encryption scheme" and "if the requested content does not reside on the first hard disk recorder, determining whether the requested content resides in the encrypted form on a second hard disk recorder".

Barton discloses transferring media and database elements between two DVRs where one of the DVRs is a portable DVR. (Barton, para. 0076.) Barton teaches a method "to encrypt the data transfer between the DVRs." (Barton, para. 0079.) Barton also discloses, at paragraph 0085, that an encrypted media stream may be saved to disk on a first DVR, and may be transferred between two DVRs. However, neither Barton nor Reese teaches "determining whether the requested content resides in the encrypted form on a second hard disk recorder." Thus, Barton does not provide a disclosure that remedies the deficiencies in the primary citation to Reese.

Since Barton fails to supply features missing from Reese, the combination of Reese and Barton cannot suggest the invention and cannot render the claims obvious. Thus, no matter how Reese and Barton may be combined (even assuming, arguendo, that

one of ordinary skill in the art would be led to combine them) the resulting combination is not the invention recited in claim 1.

It is further submitted that Barton *teaches away* from "determining whether the requested content resides in the encrypted form on a second hard disk recorder," and "displaying the requested content on a display device coupled to the first hard disk recorder," as required by claim 1. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)) The path taught by Barton is "to encrypt the data transfer between the DVRs" (para. 0079) and "to encrypt the data during the transfer" (para. 0080). Barton also discloses that an encrypted data stream may be transferred between two DVRs if it has previously been stored on the **first** DVR as an encrypted media stream (para. 0085). Barton then teaches displaying the content at the **destination** DVR, not the first DVR (see para. 0087). Thus, a person of ordinary skill, upon reading Barton, would be led in a direction divergent from the path that was taken by the Applicant.

Applicant respectfully submits that Barton fails to provide a basis for a rejection under 35 U.S.C. § 103, at least because Barton *teaches away* from determining whether the requested content already resides in an encrypted form on the second hard disk recorder, and viewing it on a display device coupled to the first hard disk recorder, as recited in claim 1. Because Barton is an improper basis for rejecting Applicant's claims, the combination of Barton with Reese, or with other prior art references, is also an improper basis for rejecting Applicant's claims.

Claims 2-3 and 10-12 are dependent upon claim 1. Because claims 2-3 and 10-12 depend from an allowable base claim, the cited combination of Reese and Barton, or of Reese and Barton further in view of Asano, cannot render claims 2-3 and 10-12 obvious. Therefore, Applicant submits that claims 2-3 and 10-12 are patentable over the cited art, and requests that the rejection be withdrawn. Reconsideration of the rejections under 35 U.S.C. § 103 is respectfully requested.

Conclusion

In view of the foregoing discussion, it is believed that claims 1-3 and 10-12 are allowable over the cited art. Applicant respectfully submits that all pending claims, as amended, are in condition for allowance, and earnestly requests that all objections and rejections of the claims be withdrawn and a Notice of Allowance be entered at the earliest date possible.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

Respectfully submitted,
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